

RECEIVED
CENTRAL FAX CENTER

JUL 01 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Applicant: Plow)	Art Unit: 3671
)	
Serial No.: 09/922,182)	Examiner: Mammen
)	
Filed: August 2, 2001)	STL9-2000-0035-US1
)	
For: SYSTEM, METHOD, AND COMPUTER)	July 1, 2005
PROGRAM PRODUCT FOR STORING INTERNET)	750 B STREET, Suite 3120
ADVERTISEMENTS AT A USER COMPUTER)	San Diego, CA 92101
)	

REPLY BRIEF

Commissioner of Patents and Trademarks
Washington, DC 20231

Dear Sir:

This brief responds to the Examiner's Answer dated June 13, 2005. The examiner begins his new arguments with a riff on why requiring the proponent of evidence - in this case, a patent examiner - to establish a date of the evidence "contorts the MPEP". What contorts U.S. legal principles is permitting an examiner to base a rejection on a reference that on its face is not prior art, without having to deal with the bother of demonstrating why the date of an underlying provisional application that is not in evidence should be accorded to the reference sought to be used against the claims. In support of what must be one of the most specious arguments encountered during prosecution of a patent, the examiner mentions burdens in showing lack of written description and on litigation parties asserting invalidity, blissfully unaware that in the examples cited the examiner is pointing out burdens that have been properly placed *on the party proponent*. Who, in case the point remains opaque, is the examiner in this case.

1176-3.RPL

CASE NO.: STL9-2000-0035-US1

Serial No.: 09/922,182

July 1, 2005

Page 2

PATENT
Filed: August 2, 2001

This is critical, because if the Board agrees that the burden is on an examiner to demonstrate why an asserted reference that on its face fails to predate an application nonetheless should be accorded an earlier date of a provisional application not in evidence, then the Board must consider the table in support of the examiner's position, offered for the first time during prosecution in the Answer. And if the Board indeed considers the table, it will conclude that what Appellant has been arguing about the reference not being prior art is valid. Consider that while the second row of the table quotes the Kim published application as downloading information without user request, it does not, because it cannot, do so in the context of the provisional. Rather, the provisional is quoted for stating that clients (which could be humans, not machines) retrieve messages autonomously, with necessary but untaught language helpfully inserted in brackets by the examiner in a disingenuous attempt to shore up a bankrupt case.

This pattern of the examiner adding words to the paucity of the teachings of the Kim provisional continues in the third row of the table, when the examiner clarifies that what Mr. Kim must have meant in his provisional when he said "to show the message" is "advertisement". Appellant can play the same game and interpret "message" in the Kim provisional to mean, well, "message", such as instant messages, and not to refer to advertisements. The fifth column, which quotes jargon in the Kim provisional about "full browser based one-click instant presentation", has been used as a teaching of allowing a user to access saved advertisements in an advertising history window displaying Internet content composed of plural advertisements. But of course, the quote from the provisional states nothing about windows, much less the one particularly recited in Claim 1.

Continuing the deconstruction of Kim and, hence, of the rejections, consider the allegation inherent in the sixth column of the table that teachings about expiration dates, and the ability of users to delete or store

1176-3.RPL

CASE NO.: STL9-2000-0035-US1
Serial No.: 09/922,182
July 1, 2005
Page 3

PATENT
Filed: August 2, 2001

e-catalogue entries, is the same thing as allowing a user to filter previously displayed advertisements, so that only advertisements corresponding to one or more user selected attributes are eligible for display. What filtering attributes are possibly being taught in the provisional?

Consider next the seventh column, which plainly admits that while the Kim publication teaches URLs, the provisional does not. Rather, the examiner damns his own case by admitting on the record that the provisional teaches only that the relied-upon e-catalogue entries can have various *formats* including animation, video, banner, static images, HTML pages, letters, and other unnamed and from reading the Kim provisional unknown "formats" - but NOT URLs or other things that might serve as links to Web sites, which are not considered to be "formats" in any case. The last column of the table is of no further help, illustrating only that using an E-catalogue (but not hyperlinks) a user can "backtrack" to collect product information, part of which may indeed come from a web page, but so what? That is not the same thing as what is being claimed.

The examiner next alleges that "Appellant is arguing outside the scope of its claims" when it observes that Kim fails to disclose displaying plural advertisements, because Kim, even if it displays only one ad, can be said, per the examiner, to display plural ads, just in sequence. The Board is invited to consider whether this argument is being made in good faith in relation to the limitation of Claim 1 that a user is allowed to access saved advertisements in an advertising history window displaying Internet content composed of plural advertisements. If the window displays Internet content, and that content is composed of plural ads, how is Appellant arguing outside the scope of the claims?

The examiner attempts to rebut the above point by alleging that an ad history window with plural ads is not supported by the written description. However, a Section 112 rejection has not been levied, so the

1176-3.RPL

CASE NO.: STL9-2000-0035-US1
Serial No.: 09/922,182
July 1, 2005
Page 4

PATENT
Filed: August 2, 2001

argument is irrelevant. The claims say what the claims say, and nowhere has the examiner ever alleged in a Section 112 rejection that they are not adequately supported.

The examiner takes to task Appellant's arguments regarding the impropriety of the obviousness rejections because the claims recite "comprising", as though that is a bad thing. Trying to stay on issue, Appellant's point remains effectively un rebutted that Barnett et al. does not automatically download its coupons. All Barnett does is automatically delete and update coupons, but nowhere automatically downloads them *in electronic form or otherwise* as recited in the present claims.

Further, Appellant's strong rationale as to why no fair prior art suggestion to combine the references as proposed remains un rebutted. Modifying Barnett et al. to download the coupons automatically would defeat a purpose of Barnett et al. (to allow a user to decide what coupons to download) and thus would be improper under MPEP §2143.01 (citing In re Gordon), rendering the present claims patentable.

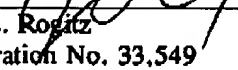
In addition, regardless of whether Landsman et al. shows that various features "are familiar", what is legally required to make a proper *prima facie* case of obviousness is a prior art showing of a suggestion to combine "familiar features" with particularly recited elements. All patent claims are directed to combinations of features that individually are "familiar".

11763.RPL

CASE NO.: STL9-2000-0035-US1
Serial No.: 09/922,182
July 1, 2005
Page 5

PATENT
Filed: August 2, 2001

Respectfully submitted,



John L. Rogitz
Registration No. 33,549
Attorney of Record
750 B Street, Suite 3120
San Diego, CA 92101
Telephone: (619) 338-8075

JLR:jg

1176-3.RPL